

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claims 1, 5, 10, 14 and 19 are amended and claims 4 and 7-9 are canceled. These amendments to the claims constitute a bona fide attempt by applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Support for the amendments can be found throughout the specification (e.g., page 3, line 24 to page 4, line 3; page 6, lines 3-9; page 7, line 24 to page 8, line 4), figures (e.g., FIG. 2), and claims (e.g., previously presented claims 4 and 7-9) and thus, no new matter has been added. Claims 1-3, 5, and 10-21 are pending.

Claim Rejections - 35 U.S.C. § 103

Claims 1-5, 7, 8, 11, and 14-21 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reichelt et al. (U.S. Patent No. 6,295,447; "Reichelt") in view of Pearson (U.S. Patent App. Pub. No. 2005/0100152). Claim 9 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Reichelt in view of Pearson and further in view of Valentine et al. (U.S. Patent No. 6,487,209; "Valentine"). Claims 10, 12, and 13 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Reichelt in view of Pearson, and further in view of well known prior art. These rejections are respectfully, but most strenuously, traversed.

Applicants respectfully submit that the Office Action's citations to the applied references, with or without modification or combination, assuming, *arguendo*, that the modification or combination of the Office Action's citations to the applied references is proper, do not teach or suggest the mobile switching center that employs a DTMF digit pattern received from the calling user to make the determination that the calling user of the incoming call is the non-preferred user or the preferred user, as recited in applicants' independent claim 1.

For explanatory purposes, applicants discuss herein one or more differences between the claimed invention and the Office Action's citations to Reichelt, Pearson, and Valentine. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the Office Action's citations to Reichelt, Pearson, or Valentine correspond to the claimed invention.

Reichelt (column 10, lines 58-62; column 7, lines 8-27) discloses evaluating logical expressions to determine whether or not to execute a relevant feature. Reichelt discloses that the call waiting feature is either on or off. Reichelt fails to disclose the mobile switching center that employs a DTMF digit pattern received from the calling user to make the determination that the

calling user of the incoming call is the non-preferred user or the preferred user. This point is conceded by the Office Action (page 11, lines 1-2).

Accordingly, the Office Action's citation to Reichelt fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

Pearson (Abstract, lines 1-11) discloses:

The disclosure is directed to a method of providing a distinctive call waiting tone based on a redirecting number. The method includes receiving a call from an originating device at a redirecting device; forwarding the call from the redirecting device to a destination device; and applying a distinctive type of call waiting tone to the destination device based upon determining that a data message includes a redirecting number. The forwarded call has an associated data message that includes a calling number of the origination device, a called number of the destination device, and a redirecting number of the redirecting device.

Pearson discloses the distinctive call waiting tone based on the redirecting number. Pearson fails to disclose the mobile switching center that employs a DTMF digit pattern received from the calling user to make the determination that the calling user of the incoming call is the non-preferred user or the preferred user. This point is conceded by the Office Action (page 11, lines 1-2).

Accordingly, the Office Action's citation to Pearson fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

Valentine (Abstract) discloses:

The present invention provides a system and method for reliably transferring Dual Tone Multiple Frequency (DTMF) signals originating at a MS through an IP based GSM network. In general, when a MS sends a DTMF request, it is processed in the IP network by a logical application module in a MSC, which, based on the disclosed processing, activates another logical application module in an appropriate gateway (for independent, remote, tone generation), and then the logical application module in the gateway directs the production of the DTMF signal towards the interworking or destination network.

Valentine discloses sending a message indicative of a DTMF tone to the MSC and then generating a DTMF tone at a gateway for independent and remote tone generation. Valentine fails to disclose receipt of the DTMF digit sequence by the MSC or a determination based on the DTMF digit sequence. Valentine fails to disclose the mobile switching center that employs a DTMF digit pattern received from the calling user to make the determination that the calling user of the incoming call is the non-preferred user or the preferred user.

Accordingly, the Office Action's citation to Valentine fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

With respect to the combination of the Office Action's citation to Reichelt and Pearson with the Office Action's citation to Valentine, applicants respectfully submit that when undertaking an inquiry into the obviousness of an invention, a determination must be made regarding whether, at the time the invention was made, the invention would have been obvious to one of ordinary skill in the art to which the subject matter of the invention pertains. Applicants strenuously travers the § 103 rejection of the claimed invention on the following bases:

(1) The justification in the Office Action for combining the citations to Reichelt and Pearson and the citation to Valentine does not identify any express teaching, suggestion, or incentive in the art for this combination;

(2) The justification in the Office Action for combining the citations to Reichelt and Pearson and the citation to Valentine is nothing more than hindsight reconstruction of the claimed invention, which is impermissible when formulating an obviousness rejection;

(3) The prior art as a whole must be considered when formulating an obviousness rejection, and since Valentine is directed to a different problem than that addressed by the claimed invention, the invention cannot be obvious from a combination of the Office Action's citations to Reichelt, Pearson, and Valentine.

First, the Office Action states (page 11, lines 7-9) as a justification to combine the citations to Reichelt and Pearson and the citation to Valentine:

It would have been obvious to one of ordinary skill in the art to combine the teaching of Valentine et al. with Reichelt and Pearson for the purpose of transferring DTMF tones through an IP based GSM network.

This justification for combining the Office Action's citation to Reichelt and Pearson and the Office Action's citation to Valentine conspicuously fails to identify any express teaching, suggestion, or incentive in the art for making the combination. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion that the combination be made. Either the Office Action must identify an express teaching, suggestion, or incentive in the art, or the Office Action must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious. Since no express teaching or suggestion in the art has been identified, attention must be turned to the reasoning to determine whether it is convincing regarding whether the claimed invention is obvious.

Second, in this regard, the justification is nothing more than hindsight restatement of the results of the claimed invention.

... for the purpose of transferring DTMF tones through an IP based GSM network.

This justification is tantamount to stating that "it would be obvious to modify A to have B because it provides A plus B." This line of reasoning cannot be considered "convincing," since it is settled that it is impermissible to simply engage in hindsight reconstruction of the claimed invention, using the claimed invention as a template and selecting elements to fill the gaps.

Further, since this justification is hindsight reconstruction of the results of the claimed invention, the Office Action's reasoning is actually using the claimed invention itself as a basis

to combine the citation to Reichelt and Pearson and the citation to Valentine. This violates the settled principle that a motivation to combine references cannot come from the invention itself.

Applicants respectfully submit that the claimed invention would not have been obvious, namely, no express teaching or suggestion in the documents for the combination has been identified, and further, the justification given in the Office Action for combining the citation to Reichelt and Pearson and the citation to Valentine is not convincing since it is nothing more than hindsight reconstruction of the claimed invention using pieces of the documents to fill the gaps.

Third, applicants respectfully submit that Valentine when considered as a whole is not directed to the problem addressed by the claimed invention.

Valentine is directed towards sending DTMF signals to a destination network (Abstract):

The present invention provides a system and method for reliably transferring Dual Tone Multiple Frequency (DTMF) signals originating at a MS through an IP based GSM network. In general, when a MS sends a DTMF request, it is processed in the IP network by a logical application module in a MSC, which, based on the disclosed processing, activates another logical application module in an appropriate gateway (for independent, remote, tone generation), and then the logical application module in the gateway directs the production of the DTMF signal towards the interworking or destination network.

Valentine discloses sending a message indicative of a DTMF tone to the MSC and then generating a DTMF tone at a gateway for independent and remote tone generation. Valentine fails to disclose receipt of the DTMF digit sequence by the MSC or a determination based on the DTMF digit sequence.

In contrast, applicants' claim recites the mobile switching center employs a DTMF digit pattern received from the calling user to make the determination that the calling user of the incoming call is the non-preferred user or the preferred user.

Accordingly, Valentine is directed to a significantly different problem than the claimed invention. Valentine, when considered as a whole, is not directed to the problem of the claimed invention, and therefore should not be combined with the citations to Reichelt and Pearson in the manner set forth in the Office Action.

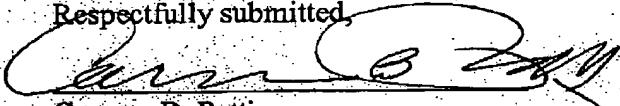
The Office Action's citations to Reichelt, Pearson, and Valentine all fail to meet at least one of applicants' claimed features. For example, there is no teaching or suggestion in the Office Action's citations to Reichelt, Pearson, or Valentine of the mobile switching center that employs a DTMF digit pattern received from the calling user to make the determination that the calling user of the incoming call is the non-preferred user or the preferred user, as recited in applicants' independent claim 1.

For all the reasons presented above with reference to claim 1, claims 1, 14, and 19 are believed neither anticipated nor obvious over the art of record. The corresponding dependent claims are believed allowable for the same reasons as independent claims 1, 14, and 19, as well as for their own additional characterizations.

Withdrawal of the § 103 rejections is therefore respectfully requested.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,


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Dated: October 17, 2006

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